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Application/Control Number: 09/625,660

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/625,660

Filing Date: July 26, 2000

Appellant(s): Merritt, Frederick, Jr.

David W. Nagle, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/29/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

The appellant's statement that the claims stand or fall together is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,061,660	EGGLESTON	5-2000
5,724,521	DEDRICK	3-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston (6,061,660) in view of Dedrick (5,724,521).

Claim 1, 9, 10, 11, 12, 14: Eggleston discloses a system, network for re-directing users of a global information network to specific advertisements resident on said network, wherein said system includes a sweepstakes component, comprising:

a first database storing and maintaining identifying information related to a plurality of users, said users having registered with the system and being classified as a sweepstakes player, a prize presenter, or an advertiser (col 10, lines 1-10). Eggleston discloses that retailer's register and that retailer's can be advertisers (col 13, line 65-col 14, line 5; col 1, lines 35-40; col 10, lines 1-10).

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Eggleston further discloses a second database storing and maintaining information related to a plurality of prizes to be distributed through the sweepstakes component of the system, each of said prizes being associated with a prize presenter registered with the system (col 14, line 65-col 15, line 15); and

a third database storing and maintaining target advertising profiles, each of said profiles being associated with an advertiser registered with the system (col 42, lines 35-40). Eggleston further discloses that the sponsor can also be an advertiser (col 34, lines 41-46; col 21, lines 14-18).

Eggleston further discloses that when a sweepstakes player enters a sweepstakes for a particular prize, the identifying information related to said sweepstakes player stored and maintained in said first database is compared to the target advertising profiles stored and maintained in said third database (col 42, lines 31-40; col 41, lines 55-65).

Eggleston further discloses that said user is directed to a specific program of a particular advertiser registered with the system based on said comparison (col 31, lines 35-40; col 42, lines 35-40).

Eggleston does not explicitly state that the user is directed to the advertising based on the comparison.

However, Eggleston further discloses that the incentives information can include advertising (col 34, lines 41-47). Eggleston further discloses directing the user to advertising (col 1, lines 36-41) and targeting the user to particular programs (col 31, lines 35-40; col 42, lines 35-40).

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Therefore, it would be obvious to Eggleston that the advertising the user is directed to can be targeted. One would have been motivated to do this so that the user goes to a site they are more likely interested in.

Eggleston further discloses profiling or targeting a user (col 31, lines 35-40; col 42, lines 35-40), directing the player to advertising (col 1, lines 35-41).

Eggleston does not explicitly disclose that said particular advertiser pays a predetermined amount for the directing of said sweepstakes player to the specific advertisement.

However, Dedrick discloses playing games (col 2, lines 61-64) and charging for directing a user to advertising (col 2, lines 5-10);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's charging for directing advertising to Eggleston's directing user's to advertisements. One would have been motivated to do this because it is targeted users are of interest to advertisers.

Eggleston does not explicitly disclose that the prize can be delivered once the cost of that prize or a surplus of that cost has been satisfied.

However, Eggleston further discloses distributing a particular prize once a predetermined threshold is met (col 30, line 65-col 31, line 5). Eggleston further discloses that prizes cost money (col 15, lines 6-15). Eggleston further discloses tracking sponsor expenses (col 39, lines 40-51).

Therefore, in light of Eggleston being able to charge for directing advertising as disclosed above, it would have been obvious to Eggleston to offer the prize once the cost of the prize has

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been satisfied. One would have been motivated to do this so that the sponsor can assure that their expenses are well maintained.

Eggleston further discloses that the advertisements can be located on websites each associated with one of said registered advertisers (col 1, lines 35-40; col 8, lines 30-43) and a particular advertising profile (col 30, lines 25-30; col 13, line 65-col 14, line 5; col 31, lines 35-40; col 42, lines 35-40).

Eggleston further discloses collecting demographic information on the player (col 13, lines 5-27).

Eggleston further discloses the prize presenter disclosing a selling price for each prize (col 15, lines 3-15; col 42, lines 33-40).

Eggleston further discloses the player selecting a prize (col 26, lines 10-19).

Eggleston further discloses that the retailer and the sponsor can be the same (col 21, lines 14-18) or different (col 10, lines 1-10).

Claim 2: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that said databases are maintained and accessed by a central control computer integrally connected to said global information network (col 10, lines 4-6; col 11, line 65-col 12, line 11; Fig. 6; Fig. 2).

Claim 3: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that said global information network is the World Wide Web portion of the global Internet (col 5, lines 45-55).

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Claim 4: Eggleston and Dedrick disclose a system as recited in claim 3, and Eggleston further discloses that said system is accessed by users through an Internet browser (col 8, lines 25-30).

Claim 5: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that the identifying information associated with each sweepstakes player comprises a plurality of discreet demographic descriptors (Fig. 16).

Claim 6: Eggleston and Dedrick disclose a system as recited in claim 5, and Eggleston further discloses that said advertising profiles are defined by a plurality of discreet demographic descriptors (col 31, lines 35-40; col 42, lines 35-40).

Claim 7: Eggleston and Dedrick disclose system as recited in claim 6, and Eggleston further discloses that the comparison of the identifying information related to each said sweepstakes player to each said target advertising profile is carried out through a comparison of the discreet demographic descriptors (col 31, lines 35-40; col 42, lines 35-40).

Claim 8: Eggleston and Dedrick disclose a system as recited in claim 1, and Eggleston further discloses that a selling price for each of said prizes is established by the associated prize presenter (col 15, lines 3-15; col 42, lines 33-40).

Claim 13: Eggleston and Dedrick disclose a method as recited in claim 12, and Eggleston further discloses that a predetermined sum is a paid to a presenter of said awarded prize (col 15, lines 7-15).

(11) Response to Argument

Examiner notes that it is not a 35 USC 102 rejection that was made with either Eggleston or Dedrick. Rather, a 35 USC 103 rejection utilizing Eggleston and Dedrick was made for all claims. Examiner admits that Eggleston or Dedrick alone do not disclose all the Applicant's features. Rather, it is the combination of Eggleston and Dedrick that disclose the Applicant's invention as stated in the claims. Hence, the combination of Eggleston and Dedrick must be considered as the prior art for every claim.

As to the propriety of the combination of Eggleston and Dedrick, Eggleston is directed towards providing incentive programs to promote products or services (col 1, lines 26-31). Eggleston is further directed to providing incentive programs to encourage viewing advertising, purchasing a product, increase product awareness, launch new products, differentiate products, obtain information, etc (col 1, lines 36-46). Eggleston's invention can operate on the Internet (col 1, lines 45-50). Eggleston further discloses targeting or profiling a user (col 42, lines 36-38; col 5, lines 26-36) and tracking a user's activities including incentive participation, award fulfillment, and purchasing (col 13, lines 15-20; col 39, lines 60-65; col 9, lines 56-63). Eggleston further discloses the user participating in surveys (col 13, lines 48-52) and a gaming function (col 3, lines 10-20).

Dedrick is directed towards electronic information distribution networks and providing electronic advertisements to individual end users (col 1, lines 6-14) along with other types of information (col 3, lines 24-29). Dedrick is further directed to purchasing products because of advertisements (col 9, line 65-col 10, line 10). Dedrick further discloses targeting or profiling a

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user (col 1, lines 45-57; col 2, lines 1-10) and tracking all user activities (col 7, lines 1-15) including tracking user purchases (col 9, line 65-col 10, line 6). Dedrick further discloses the user participating in surveys (col 3, lines 44-47) and a gaming function (col 2, lines 61-64).

Hence Eggleston and Dedrick are analogous and related in their objects and intent. Eggleston discloses advertising and Dedrick expounds upon the advertising aspects of promotions. Dedrick discloses purchasing products and advertising and Eggleston expounds upon incentives as a way to enhance advertising response and the purchasing of a product. Therefore, Eggleston and Dedrick are directed towards many of the same objects and it would be obvious to combine Eggleston and Dedrick in order to enhance the capabilities already present in each reference.

On page 20 of Applicant's Appeal Brief dated March 29, 2004, Applicant states, "In summary, as should be clear from the above discussion, neither the '660 Patent nor the '521 Patent provide for (1) the comparison of the identifying information of an entering sweepstakes player to target advertising profiles, with the sweepstakes player being re-directed to an advertisement of a particular advertiser based on such comparison, and/or (2) conducting a sweepstakes to distribute the particular prize once a predetermined revenue had been generated by the directing of multiple users to the matched advertisements."

However, Eggleston and Dedrick disclose the comparison of the identifying information of an entering sweepstakes player to target advertising profiles, with the sweepstakes player being re-directed to an advertisement of a particular advertiser based on such comparison.

Eggleston discloses utilizing identifying information for a user,

"The consumer may register to become a member of the host incentive program system by entering various information in a

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predetermined format. If the consumer registers, the consumer is then issued an identification number and an associated password" (col 12, lines 25-30 and Fig. 17).

Eggleston further discloses that the user can be a sweepstakes player,

"Thus, a typical consumer may log on to the web site, register as with the host system, and participate in one or more incentive programs. The incentive programs could include, for example, scratch-and-win games, sweepstakes games, treasure hunt games, or computer games" (col 13, lines 41-47).

Eggleston discloses that it is obvious to target promotions to match customer profiles,

"Computer systems and methods for generation of computer software programs based on underlying data are also known. For example, U.S. Pat. No. 5,576,951 to Lockwood discloses an automated sales and services system that composes individualized sales presentations from various textual and graphical information data sources to match customer profiles entered into the system. However, known computer systems do not provide for automatic generation of incentive programs based on parameters entered by a sponsor company" (col 5, lines 26-36).

Eggleston discloses targeting promotions by user profile,

"The sponsor can select the target of the incentive program, which can, for example, be employees, suppliers, or customers of the sponsor" (col 31, lines 36-41 and Fig. 20, "Target of Incentive Effort"),

and

"Sponsors are able to target awards for giveaway by demographic preferences or geography" (col 42, lines 36-38).

Eggleston further discloses tracking a variety of user profile and demographic information,

"A winning sub-record 818 may record information regarding winning activities by the consumer. An award or points sub-record 820 may record loyalty points or prizes won by the consumer. A psychographic or demographic sub-record 822 may include information obtained through consumer responses to

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inquiries answered by the consumer during participation in incentive programs. Any number of other sub-record containing information about the consumer or about the consumer's participation in incentive programs should be understood to be encompassed within the present system" (col 13, lines 17-29),

and

"The sponsor site 194 also permits the sponsor to link directly to the consumer site 192 and to query the consumer database 200 to obtain information regarding consumer participation in that sponsor's incentive programs. Thus, the sponsor can obtain psychographic, demographic, or other information relevant to the participation of consumers in the sponsor's incentive programs" (col 15, lines 18-26).

Additionally, the online Merriam-Webster dictionary at 'www.m-w.com' defines advertising as:

"to call public attention to especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize : **PROMOTE**"

Hence, Eggleston explicitly discloses advertising and Eggleston discloses incentives or promotions which are a form of advertising as defined by Merriam-Webster,

"Incentive programs offer awards and incentives to modify behavior of individual consumers and to direct the consumers to some pre-determined action, such as purchase of products or services upon visiting a retail site, viewing advertising, testing a product, or the like. Companies use awards and incentives to increase awareness of product offerings, to launch new products, to attract the attention of a newly identified audience, to differentiate products to encourage certain behavior, to obtain information, and for other purposes" (col 1, lines 35-45).

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Therefore, Eggleston discloses that user identifying information, user demographic information, and user profile information can be utilized for targeting promotions/incentives/advertising to direct a user to particular advertising information.

Additionally, Dedrick discloses the comparison of the identifying information of an entering user to target advertising profiles, with the user being re-directed to an advertisement of a particular advertiser based on such comparison,

"The billing process 54 of the clearinghouse server can also direct a unit of electronic information to metering servers that service end users with a profile that correlates to a targeted user profile characteristic. For example, the publisher may request that a unit of electronic information be directed to end users with a certain income, etc. The demographic database 50 may contain data relating to which metering servers 14 service end users with corresponding user profile characteristics. The clearinghouse server 20 correlates the requested user profile data with certain identified metering servers and sends the unit of electronic information only to the selected metering servers, which then forward the electronic information to the end users. The clearinghouse server may also have a subscriber database 58 that contains a list of all the metering servers and whether a subscribing end user is associated with the metering server" (col 14, lines 51-67).

Hence in reference to the set of features listed as (1) above, Eggleston and Dedrick disclose the comparison of the identifying information of an entering sweepstakes player to target advertising profiles, with the sweepstakes player being re-directed to an advertisement of a particular advertiser based on such comparison.

In reference to the set of features listed as (2) above, the combination of Eggleston and Dedrick disclose conducting a sweepstakes to distribute the particular prize once a predetermined revenue had been generated by the directing of multiple users to the matched advertisements.

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Eggleston does not explicitly disclose that the prize can be delivered once the cost of that prize or a surplus of that cost has been satisfied.

However, Eggleston discloses setting thresholds and parameters in terms of award fulfillment and Eggleston discloses that prizes cost money,

"On selecting a type of incentive program, the sponsor is prompted at a step 364 to enter parameters that are associated with that type of incentive program, such as the duration of the incentive program, the number of winners who may participate in the incentive program, the frequency of winning, and the like" (col 19, lines 8-15),

and

"Prize selection requires the sponsor to enter various data for each incentive program, including the number of prizes, the frequency of winning, relative prize weighting (e.g., grand prize, second prize, etc.). When a consumer wins, then the prize is selected based on an algorithm that depends on the selected prize frequency. Each prize also must have a selected mode of fulfillment, which is entered by the sponsor at the step 410 through a menu, a set of icons, or the like. Next, at a step 412 the sponsor is prompted to pay for the prize. Payment may be by any conventional means, such as electronic transmission of the sponsor's credit card number" (col 20, lines 9-20).

Eggleston further discloses that user participation thresholds are tracked in terms of award fulfillment,

"Combinations of different types of incentive programs may be selected; for example, an incentive program may be built in which the consumer plays a pinball game in which the consumer is eligible to win customer loyalty points, and upon winning enough points, the consumer is eligible for a sweepstakes prize" (col 30, line 63-col 31, line 2),

and

"Alternatively, incentive programs may be customer loyalty programs in which consumers accumulate points for performing

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certain actions, and the accumulation of a defined number of points permits eligibility for a prize" (col 35, lines 25-30).

Eggleston further discloses that prizes cost money (col 15, lines 6-15), that a retailer can be a prize presenter/sponsor (col 20, lines 33-38; col 21, lines 13-20), that the retailer establishes the selling price of each prize (col 20, line 63-col 21, line 3; col 21, lines 20-24) and that a retailer can sell a prize (col 22, lines 15-19).

Eggleston further discloses tracking sponsor/retailer/prize presenter expenses, "Thus, a price sub-record 878 may include the price for the award. A geographic sub-record 880 may identify the geographic locations, such as the ZIP code, at which the award is available. A fulfillment sub-record 882 may include information necessary to identify fulfillment options for the award. A billing sub-record 884 may include further sub-records that include historical billing information for each sponsor who has purchased an award for offering in connection with an incentive program" (col 39, lines 40-51),

and that the cost of the incentive program and award fulfillment is a burden to sponsors,

"A similar problem exists for sponsoring companies who wish to offer promotions. The collective costs of generating incentive programs, administering the incentive programs, tracking the participation of consumers in the incentive programs and fulfilling the awards or prizes won in such incentive programs may exceed the benefits of offering the incentive program. These costs may be particularly high in instances where the activities associated with an incentive program must be carried out by different companies, or by different organizations within the same company. Accordingly, a need has arisen for a unified system that provides for program generation and administration, data tracking and award fulfillment" (col 1, line 63-col 2, line 8).

Eggleston discloses that the user can visit a sponsor site or view advertising as a recorded participating activity (col 1, lines 39-41; col 27, lines 3-6).

Dedrick discloses pay per view charging to advertisers,

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- ✓ "For example, when an end user consumes a unit of electronic information, data relating to the consumption of the electronic information may be sent from the billing server 14 to the clearinghouse server 20. The session manager 56 instructs the billing process 54 to charge the publisher/advertiser account within the transaction database 52" (col 14, lines 34-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's pay per view charging to advertisers to Eggleston's recording of directing a user to advertising and Eggleston's sponsors burdened by the cost of providing awards and Eggleston's setting of thresholds for award fulfillment. One would have been motivated to do this in order to provide a source of revenue for sponsors such that sponsor's can continue providing the incentive program.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AD

April 20, 2004

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jlw 5-17-04

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